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ZINUS, INC.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

ZINUS, INC., a California corporation,

Plaintiff,

v.

SIMMONS BEDDING COMPANY, a
Delaware corporation, and DREAMWELL,
LTD., a limited liability company of
Nevada,

Defendants.

DREAMWELL, LTD., a limited liability
company of Nevada,

Counterclaimant,

v.

ZINUS, INC., a California corporation,

Counterdefendant.

Case No. 07-CV-03012 PVT

**PLAINTIFF ZINUS, INC.'S REPLY
TO DREAMWELL'S OPPOSITION
TO ZINUS' MOTION FOR RECON-
SIDERATION OF THE ORDER
DENYING ZINUS' MOTION FOR
SUMMARY JUDGMENT OF
NON-INFRINGEMENT**

Date: January 22, 2008
Time: 10:00 a.m.
Location: Courtroom 5
Judge: Hon. Patricia V. Trumbull

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MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

In the papers filed in support of and in opposition to Zinus' Summary Judgment Motion¹ and Motion for Reconsideration, the decision on whether Zinus' swirl wrap method infringes any claim of U.S. Patent No. Re 36,142 ("the '142 Patent") has come to depend on whether a particular claim element of the '142 Patent was amended so as to narrow the scope of that claim element and thereby estop defendant and counterclaimant Dreamwell, Ltd. ("Dreamwell") from now recapturing surrendered claim scope through the doctrine of equivalents in order to cover Zinus' swirl wrap method. In Dreamwell's Opposition to Zinus' Motion for Reconsideration (hereinafter "Dreamwell's Opposition"), Dreamwell contends that the amendments made during the prosecution of the '142 Patent did not limit or restrict the characteristics of the "containment sleeve" term. [Dreamwell's Opposition, 10:13-14] Because this contention is false, Dreamwell is estopped from expanding the scope of the "inserting . . . into a containment sleeve" element so as to cover the step of the swirl wrap method that involves rolling up a mattress together with a sheet of film and tape or bands.

As a fallback argument, Dreamwell now claims that it is entitled to use two *Festo* exceptions to rebut the presumption of prosecution history estoppel where a claim element has been amended for patentability purposes. After admitting in its Opposition to Zinus' Summary Judgment Motion that the "inserting . . . into a containment sleeve" element was amended for patentability purposes, Dreamwell had the burden of rebutting the presumption of prosecution history estoppel by showing that it was entitled to a *Festo* exception. Dreamwell failed to rebut the presumption of estoppel at that time. Although Dreamwell now raises new arguments concerning *Festo* exceptions, those new arguments are also inadequate to rebut the presumption of estoppel.

II. LITERAL INFRINGEMENT

As a preliminary matter, Dreamwell has now effectively admitted in Dreamwell's

¹ Plaintiff and Counterdefendant Zinus, Inc.'s ("Zinus") Motion For Summary Adjudication of Non-

1 Opposition that the swirl wrap method of rolling up a sheet of film together with a
2 compressed mattress does not literally infringe any claim of the ‘142 Patent. Zinus stated in
3 its Summary Judgment Motion that “[n]o containment sleeve is involved in the ‘swirl wrap’
4 packaging method. Accordingly, the ‘swirl wrap’ packaging method cannot literally infringe
5 any claim of the ‘142 Patent.” [Zinus’ Summary Judgment Motion, 7:16-18; see also 19:5-8]
6 Zinus also stated in its Motion for Reconsideration, “The issue of literal non-infringement
7 has been effectively conceded by Dreamwell. Dreamwell has not even attempted to argue
8 literal infringement.” [Zinus’ Motion for Reconsideration, 6:17-18] Dreamwell now admits
9 in its Opposition that “Zinus has not argued and cannot seriously argue its combination of
10 reinforced fabric and bands of tape or plastic stripping was literally covered by the original
11 claims of the ‘142 Patent . . .” [Dreamwell’s Opposition, 9:18-20] Considering that the
12 original claims of the ‘142 Patent were narrowed as opposed to expanded by the subsequent
13 amendments, Dreamwell’s statement is an admission that the swirl wrap method is not
14 literally covered by the narrower allowed claims of the ‘142 Patent.

15 Dreamwell nevertheless attempts, however, to avoid a finding of no literal
16 infringement by arguing that “Zinus never moved for a partial summary judgment on that
17 [literal] theory of infringement. Rather, Zinus moved for summary judgment on infringement
18 as a whole.” [Dreamwell’s Opposition, fn 5] Contrary to Dreamwell’s statement, Zinus is
19 entitled to a finding that the swirl wrap method does not literally infringe any claim of the
20 ‘142 Patent because (i) Dreamwell has presented no case for literal infringement, (ii) Zinus
21 has demonstrated that no containment sleeve whatsoever is involved in the swirl wrap
22 method, and (iii) Zinus moved for a finding “that the Swirl Wrap packaging method as
23 defined in Zinus’ Memorandum of Points and Authorities and in the accompanying
24 declaration of Scott Reeves does not fall within the scope of any claim of U.S. Patent No. Re.
25 36,142, either literally or under the doctrine of equivalents.” [Zinus’ Proposed Order
26 Granting Zinus’ Summary Judgement Motion (emphasis added)]

27
28

Infringement filed on October 2, 2007.

1 **III. PROSECUTION HISTORY ESTOPPEL PRECLUDES EXPANDING THE**
2 **“INSERTING” ELEMENT UNDER THE DOCTRINE OF EQUIVALENTS**

3 Dreamwell argues that the doctrine of prosecution history estoppel is inapplicable to
4 the “containment sleeve” term within the “inserting” claim element. To determine whether
5 prosecution history estoppel precludes the “inserting” claim element from being expanded
6 under the doctrine of equivalents to cover the “rolling up” step of the swirl wrap method, the
7 four questions outlined in *Festo X* should be analyzed. *Festo Corp. v. Shoketsu Kinzoku*
8 *Kabushiki Co.*, 344 F.2d 1350, 68 U.S.P.Q.2d 1321, 1326 (Fed.Cir. 2003) (*Festo X*). First,
9 the literal scope of the claim element must have been narrowed by amendment. Second, the
10 reason for the amendment must relate to patentability. If the prosecution history reveals no
11 reason for the narrowing amendment, the reason is presumed to relate to patentability, and
12 the patentee may rebut the presumption that a narrowing amendment was made for
13 patentability reasons and overcome this amendment-based estoppel. Third, if the patentee
14 does not rebut the presumption under amendment-based estoppel or if the prosecution history
15 record indicates that an amendment was made for patentability purposes (argument-based
16 estoppel), then the claim scope surrendered includes the subject matter between the original
17 claim element and the amended claim element. Of course, subject matter beyond the scope
18 of the original claim language has also been surrendered, as explained below in Section D.
19 Fourth, the patentee may rebut the presumption that a particular equivalent that falls between
20 the original claim element and the amended claim element has been surrendered by
21 demonstrating that one of three exceptions applies.

22 In this case, Dreamwell is precluded from expanding coverage of the claims beyond
23 the scope of the amended “inserting” claim element because (i) the “inserting” claim element
24 was narrowed by amendment, (ii) the prosecution history record indicates that the “inserting”
25 claim element was amended for patentability purposes, and (iii) Dreamwell cannot
26 demonstrate that any of the three *Festo* exceptions applies in order to rebut the presumption
27 that the alleged equivalent of a sheet and tape or plastic stripping was surrendered.
28

A. The “Inserting” Claim Element Was Narrowed By Amendment

The first question in the *Festo X* analysis concerns whether a claim element was narrowed by amendment. Dreamwell attempts to finesse this issue by arguing that even if the scope of equivalency of a claim element is limited because that element was amended for patentability purposes, an individual term within that claim element may nevertheless be entitled to a broader scope of equivalency than the narrowed claim element in which it is contained. [Dreamwell’s Opposition, 1:10-12] Dreamwell argues that prosecution history estoppel does not prevent the “inserting” claim element from covering the “rolling up” step of the swirl wrap method because “the ‘containment sleeve’ language was not substantively narrowed throughout the prosecution of the patent.” [Dreamwell’s Opposition, 9:21-22] Dreamwell places significance in the fact that the “inventors made no amendment to the ‘containment sleeve’ language itself.” [Dreamwell’s Opposition, 4:4-5]

Whether prosecution history estoppel estops a patentee from applying the doctrine of equivalents, however, is based on an element-by-element analysis as opposed to analyzing only specific claim terms within those elements. Whether the patentee is estopped from applying an equivalency is not properly determined by analyzing only individual claim terms within a claim element and ignoring the scope of the claim element that was narrowed. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40, 41 USPQ2d 1865 (1997).

The scope of an individual claim term within a claim element may not be expanded beyond the scope of the claim element whose equivalents have been restricted by amendment. Merely because an individual claim term within a claim element has not been changed does not mean that the claim term has not been narrowed by an amendment to the claim element. In this case, amendments to the claim element “inserting . . . into a containment sleeve . . . for shipment” narrowed the “containment sleeve” term in order to avoid covering the containment sleeve disclosed in the Broyles reference. Thus, Dreamwell’s statement that “those amendments did not limit or restrict the characteristics of the containment sleeve element” is inaccurate. [Dreamwell’s Opposition, 10:13-14] If the original “inserting . . . into a containment sleeve” had not been narrowed by amendment, it

would have covered sleeve 1, inner layer 42 and outer layer 43 of Broyles. The prosecution history record indicates that the applicants acknowledged that the original “inserting” claim element covered each of sleeve 1, inner layer 42 and outer layer 43 of Broyles. So the applicants argued that the amended “inserting” claim element was narrower than Broyles and did not read on sleeve 1, inner layer 42 and outer layer 43 because the amended “inserting” claim element restricted the “structure and functioning” of the claimed containment sleeve. In their amendment dated June 26, 1996, the applicants acknowledged that the “containment sleeve” term was narrowed by amending the “inserting” claim element even though the language of the “containment sleeve” term was not changed:

“In the Final Action mailed March 26, 1996, claims 1-4 were again rejected under 35 U.S.C. § 103 as being unpatentable over Broyles, U.S. Patent No. 3,611,524. In asserting this rejection, the Examiner states somewhat unclearly that sleeve 1 of Broyles holds the springs and acts as a containment sleeve. Also that the springs are held by the inner layer 42 and outer layer 43 which reads on a containment sleeve. Therefore, Broyles shows a containment sleeve 43 holding the springs in a compressed state.

Applicants respectfully traverse this basis for rejection of the claims. It is not seen how either sleeve 1 or outer layer 43 of Broyles functions in a way like the containment sleeve specifically called for in the instant claims 1-4. This is obviously so because Broyles clearly is not directed to a packaging method which permits convenient **shipment** of mattress assemblies constructed of pocketed coil springs. Broyles simply teaches a method for constructing mattresses. There is no containment sleeve in Broyles which is meant to be placed over an evacuated tube of compressed springs to indefinitely retain the springs in a compressed state **for shipment.**” [6/26/1996 Amendment, 2:23-3:18 (underlined emphasis in original, bold emphasis added), found in Exh W-F to Wallace Declaration to Zinus’ Motion for Summary Judgment]

Thus, the amendment to the “inserting” claim element narrowed the “containment sleeve” term to a sleeve that functions differently than sleeve 1, inner layer 42 or outer layer 43 of Broyles, namely a sleeve that is “meant to be placed over an evacuated tube of compressed springs to indefinitely retain the springs in a compressed state for shipment”² (emphasis

² Although Dreamwell now asserts that Zinus “cannot argue that the addition of the clause ‘for shipment’ substantively narrowed the scope of the claims at all” [Dreamwell’s Opposition, 10:21-22], Dreamwell has already admitted that the applicants narrowed the claims by adding “for shipment” in order to distinguish the Broyles reference. Dreamwell acknowledged, “Moreover, the applicants noted that ‘[t]here is no discussion or even remote suggestion in Broyles relating to the ZINUS’ REPLY TO DREAMWELL’S OPPOSITION TO ZINUS’ MOTION FOR RECONSIDERATION OF ORDER DENYING SUMMARY JUDGMENT MOTION

added). The amended claim element no longer literally reads on sleeves that are not meant to be placed over a compressed mattress for shipment. For example, the amended “inserting” claim element does not read on a sheet of film into which a compressed mattress is rolled up because the sheet of film is not dimensioned and configured to be “placed over” the compressed mattress, and the compressed mattress is not “inserted into” the sheet of film.

B. The Prosecution History Indicates That The “Inserting” Element Was Amended For Patentability Purposes

The second question in the *Festo X* analysis concerns whether a claim element was amended for patentability reasons. Dreamwell admitted in its Opposition to Zinus’ Summary Judgment Motion that the “inserting” claim element was twice amended for patentability purposes. In January 1996, the applicants first amended the “inserting” claim element by narrowing what the containment sleeve was configured to retain. [See Exh W-B to Wallace Declaration to Zinus’ Motion for Summary Judgment] The “inserting” element was amended as follows: “inserting said evacuated tube into a containment sleeve which is dimensioned and configured to retain said compressed [article] assembly in a compressed state.” (Brackets denote deletion; underlining denotes addition.) The originally recited “resiliently compressible **article**” was changed to “an **assembly** of coil springs wherein each spring is contained within an individual pocket of fabric”. Dreamwell admitted that this amendment in January 1996 was made for purposes of narrowing the “containment sleeve” term to avoid covering the containment sleeve disclosed in the Broyles reference. Regarding the amendment by the applicants, Dreamwell admitted, “They also noted that ‘[t]here is no containment sleeve disclosed in Broyles which is intended to maintain the innerspring in a compressed state after evacuation. The claims of the instant application all call for such a containment sleeve.’” [Dreamwell’s Opposition to Summary Judgment Motion, 4:2-5] Thus,

shipment of the compressed mattress. Consequently, Broyles does not need to use – or even suggest using – a containment sleeve ‘to retain said compressed mattress assembly for shipment,’ as required by the present claims.” [Dreamwell’s Opposition to Zinus’ Summary Judgment Motion, 6:14-17 (italicized emphasis in original; underlined emphasis added)] Dreamwell also admitted that

1 the “inserting” claim element was amended to limit the containment sleeve to one configured
2 to retain “an assembly of coil springs wherein each spring is contained within an individual
3 pocket of fabric” instead of a containment sleeve originally configured to retain a broader
4 “resiliently compressible article”, which was disclosed in the Broyles reference.

5 Then in June 1996, the applicants again amended the “inserting” claim element for
6 patentability purposes. Dreamwell admitted, “the inventors submitted an Amendment After
7 Final Rejection in which they added the highlighted language to the ‘containment sleeve’
8 element: ‘inserting said evacuation tube into a containment sleeve which is dimensioned and
9 configured to retain said *mattress* assembly in a compressed state *for shipment*.’”

10 [Dreamwell’s Opposition to Zinus’ Summary Judgment Motion, 4:20-23 (emphasis in
11 original)] Dreamwell again acknowledged that the amendments to the “inserting” claim
12 element limited the “containment sleeve” claim term. Dreamwell admitted:

13 “The inventors noted that in these new elements, ‘the structure and functioning of
14 applicants’ containment sleeve is more clearly and specifically defined.’ [Id.] They
15 also argued that ‘[t]here is *no containment sleeve* in Broyles which is meant to be
16 placed over an evacuated tube of compressed springs to indefinitely retain the
17 springs in a compressed state for shipment. . . . There is no suggestion at all in
18 Broyles of using a containment sleeve to retain the springs in compression.’”
19 [Dreamwell’s Opposition to Summary Judgment Motion, 5:2-7 (emphasis in
20 original)]

21 Thus, the applicants admitted that Broyles disclosed a containment sleeve, but distinguished
22 Broyles by arguing that the amended “inserting” claim element was limited to inserting an
23 evacuated tube into a containment sleeve having “the structure and functioning” of the
24 narrowed sleeve.

25 In their argument for allowability, the applicants clearly and unmistakably
26 surrendered claim coverage over any equivalent of inserting an evacuated tube into the type
27 of containment sleeve disclosed in Broyles. The applicants argued:

28 “In an effort to further clarify applicants’ invention, the Amendment is requested
for entry herein wherein the structure and functioning of applicants’ containment

“the primary function of the containment sleeve element is to restrict the compressed mattress from
expanding during shipment.” [Id. at 16;25-27 (emphasis added)]

sleeve is more clearly and specifically defined. No such element is found or even remotely suggested in Broyles. Accordingly, it is believed that the instant Amendment places the case in condition for allowance or in better condition for appeal.” [6/26/96 Amendment (emphasis added), 4:1-7, found in Exh W-F to Wallace Declaration to Zinus’ Motion for Summary Judgment]

Argument-based estoppel applies in this case because the prosecution history record indicates that the applicants limited the claim scope to avoid the Broyles reference. The applicants limited the claim scope of the amended claim to inserting an evacuated tube into a containment sleeve having “the structure and functioning” of the amended sleeve.

C. The Patentee Surrendered The Claim Scope Between The Original Claim Element And The Amended Claim Element

If the prosecution history record indicates that an amendment was made for patentability purposes, then the third step in the *Festo X* analysis is to define the subject matter between the original claim element and the amended claim element that has been surrendered. Because the record is clear that the “inserting” claim element was narrowed for patentability reasons, this case involves argument-based estoppel as opposed to amendment-base estoppel.³ The applicants surrendered claim scope to inserting a compressed mattress into any “containment sleeve” that does not have “the structure and functioning” of the sleeve in the amended “inserting” claim element.

The scope of the “containment sleeve” in the amended “inserting” claim element was surrendered over any sleeve with the structure or function of sleeve 1, inner layer 42 or outer layer 43 of Broyles. The applicants explicitly surrendered claim scope over any sleeve that is not meant to be placed over a compressed spring mattress to indefinitely retain the springs in a compressed state for shipment. Therefore, the claim scope that was surrendered includes subject matter describing a compressed mattress rolled up in a sheet of film because the sheet of film (i) has a different structure than the narrowed containment sleeve, (ii) is not dimensioned and configured to be “placed over” a compressed mattress, and (iii) the

³ The statement in footnote 6 of Dreamwell’s Opposition that amendment-based as opposed to argument-based estoppel applies in this case is incorrect because here the prosecution history record does indeed reveal the reasons for the narrowing amendments. See Festo X, 68 U.S.P.Q.2d at 1326.

1 compressed mattress is not “inserted” into the sheet of film. Dreamwell is precluded from
 2 expanding the equivalency of the “containment sleeve” term to a sheet of film that does not
 3 have the narrowed structure of the containment sleeve that was the basis for distinguishing
 4 the containment sleeve of Broyles.

5 **D. The Rolling-Up Step Is Even Outside The Scope Of The Broader Original**
 6 **“Inserting” Claim Element**

7 Dreamwell even admits that rolling up a compressed mattress in a sheet of film and
 8 wrapping the rolled up mattress with tape is outside of the scope of the original inserting
 9 claim element. Dreamwell states, “Zinus has not argued and cannot seriously argue its
 10 combination of reinforced fabric and bands of tape or plastic stripping was literally covered
 11 by the original claims of the ‘142 Patent . . .”. [Dreamwell’s Opposition, 9:18-20] Then
 12 Dreamwell concludes that, although a narrowed claim element cannot be expanded to an
 13 equivalent in the territory between an original broader claim element and the narrowed claim
 14 element, the narrowed claim element may nevertheless be expanded to an equivalent that is
 15 outside even the broader scope of the original claim element. Dreamwell argues that a
 16 patentee “is presumed to have disclaimed claim scope, but only ‘of the territory between the
 17 original claim and the amended claim.’” [Dreamwell’s Opposition, footnote 7 (emphasis
 18 added)] Dreamwell also states that “the presumption (and therefore the defense) of
 19 prosecution history estoppel only applies to limit a claim of infringement under the doctrine
 20 of equivalents where the accused equivalent was ‘within the scope of the claim before
 21 amendment, and . . . is not within the scope of the claim after amendment,. [sic]” (emphasis
 22 added). These statements by Dreamwell mischaracterize the doctrine of equivalents.
 23 Dreamwell quotes no case authority for its proposition. In fact, not only is a patentee
 24 precluded from asserting an equivalent in the surrendered territory between an original claim
 25 and a narrowed amended claim, but the patentee is also precluded from asserting an
 26 equivalent that is beyond the broader scope of the original claim.

27 Zinus has found no statement in case authority that explicitly precludes an equivalent
 28 from being asserted on subject matter that is even outside the broader scope of a pre-

1 amendment claim probably because courts have found no need to state the obvious. Subject
2 matter that was always outside the broader scope of a pre-amendment claim is not an
3 insubstantial substitute and cannot be reached by asserting an “equivalent”. Certainly the
4 *Festo VIII* and *Aquatex*⁴ cases cited by Dreamwell in Dreamwell’s Opposition do not hold
5 that an equivalent may be asserted on subject matter that was beyond even the broader scope
6 of a claim before it was narrowed by amendment. In fact, *Festo VIII* states, “Where the
7 original application once embraced the purported equivalent but the patentee narrowed his
8 claims to obtain a patent or to protect its validity, the patentee cannot assert that he lacked the
9 words to describe the subject matter in question”. *Festo VIII*, 62 USPQ2d at 1171 (emphasis
10 added). “By amending the application, the inventor is deemed to concede that the patent
11 does not extend as far as the original claim”. [*Id.* at 1707, 1712 (emphasis added)]. “A
12 patentee who narrows a claim as a condition for obtaining a patent disavows his claim to the
13 broader subject matter, . . .” [*Id.* at 1712 (emphasis added)] Here, the original claim
14 language did not embrace the purported equivalent, and the amended claim language does
15 not extend even as far as the original claim, much less beyond the original claim.

16 *Festo VIII* does not hold, as Dreamwell implies, that the surrendered territory extends
17 only as far as the original claim and not to the territory beyond the original claim. Of course,
18 the broader subject matter, including the territory beyond the original claim, is surrendered as
19 well. Where the original claim language did not embrace a purported equivalent, the
20 patentee may not argue that subject matter beyond even the original scope of an amended
21 claim comprises an “insubstantial substitute” and an “unforeseen equivalent.” The patentee
22 may not argue that he could not reasonably be expected to have drafted a claim that would
23 have literally encompassed an equivalent that lies beyond even the original claim before it
24 was amended.

25 *Aquatex* also does not hold, as Dreamwell implies, that territory surrendered by
26

27 ⁴ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 122 S. Ct. 1831, 152 L. Ed.
28 2d 944, , 62 U.S.P.Q.2d 1705 (2002) (*Festo VIII*); *AquaTex Industries, Inc. v. Techniche Solutions*,
479 F.3d 1320 (Fed.Cir. 2007).

1 amendment extends only as far as the original claim and not to the territory beyond the
2 original language of the amended claim element. In *Aquatex*, the Court held that where a
3 patentee amends and narrows one claim element, the patentee is not thereby barred from
4 asserting an equivalent to a completely different claim element that was not amended.
5 Prosecution history estoppel is analyzed on an element-by-element basis. *Aquatex*, 479 F.3d
6 at 1328. Neither argument-based nor amendment-based estoppel applied to the “fiberfill
7 batting material” element of *Aquatex* because “neither the arguments nor amendments made
8 during prosecution relate to the composition of the fiberfill batting”. [*Id.* at 1326]. Instead, a
9 completely different claim element was narrowed so that it applied only to “evaporatively
10 cooling” a person. *Aquatex* does not state that the patentee did not surrender claim scope to
11 subject matter that was broader than “evaporatively cooling” a person, including subject
12 matter beyond even the original language “employing said multi-layered, liquid retaining
13 composite as a garment or a flat sheet”. Although the Court found that the patentee was not
14 barred from asserting an equivalent to the “fiberfill batting material” element, the Court
15 nevertheless found summary judgment of non-infringement was appropriate because the
16 patentee had presented only lawyer argument and no evidence on an element-by-element
17 basis explaining the insubstantiality of the difference between the patented method and the
18 accused product.

19 In this case, Dreamwell argues that, although the narrowed “inserting” element
20 cannot be expanded to an equivalent in the territory between the original “inserting” element
21 and the narrowed “inserting” element, the narrowed “inserting” element may nevertheless be
22 expanded to an equivalent that is beyond even the broader scope of the original “inserting”
23 element. Neither established law on the doctrine of equivalents, nor the *Festo VIII* or
24 *Aquatex* cases cited by Dreamwell, supports Dreamwell’s argument. The amendment that
25 narrowed the “inserting” element for patentability reasons also estops Dreamwell from
26 expanding the scope of the narrowed “inserting” element to cover the “rolling up” step of the
27 swirl wrap method, which Dreamwell admits was not covered by the original claims of the
28 ‘142 Patent.

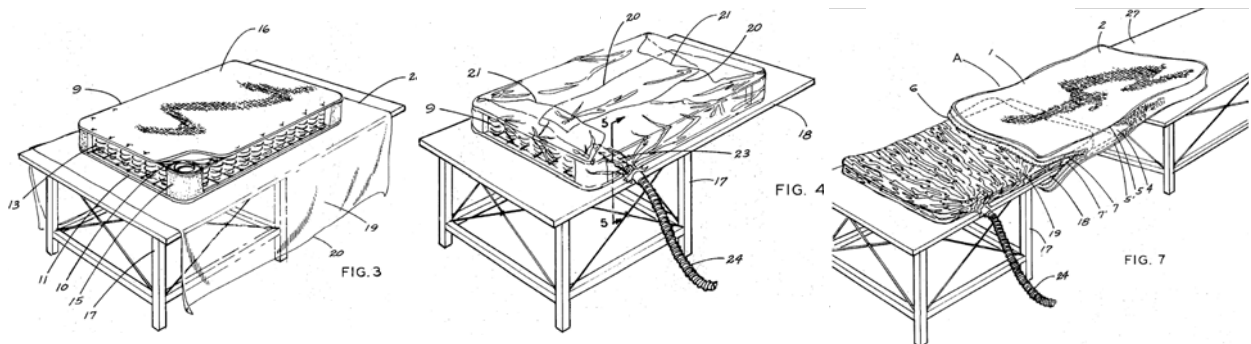
1 **IV. DREAMWELL CANNOT REBUT THE PRESUMPTION OF SURRENDER**
 2 **UNDER THE “TANGENTIAL RELATION” FESTO EXCEPTION**

3 Dreamwell claims for the first time in Dreamwell’s Opposition that it is entitled to
 4 apply two of the *Festo* exceptions to rebut the presumption that claim scope has been
 5 surrendered beyond the literal scope of a claim element that was admittedly narrowed for
 6 patentability reasons. Dreamwell asserts that it is not estopped from asserting that the
 7 combination of fabric and tape or bands is equivalent to a containment sleeve because, as
 8 Dreamwell now maintains, the rationale underlying the narrowing amendments bears “no
 9 more than a tangential relation” to the equivalent in question. To convince the Court that the
 10 narrowing amendments made to the “inserting” claim element during prosecution bear no
 11 more than a tangential relation to the alleged equivalent, Dreamwell relies on a misleading
 12 explanation of the prosecution history in an attempt to argue that the “inserting” claim
 13 element was narrowed only to change a generic recitation of “compressed articles” to a
 14 specific recitation of “coiled springs”. Dreamwell summarizes the prosecution history by
 15 recounting that the applicants amended the “containment sleeve” term as follows: “inserting
 16 said evacuation tube into a containment sleeve which is dimensioned and configured to retain
 17 said *mattress assembly* in a compressed state *for shipment*” (emphasized words added by
 18 amendment). However, Dreamwell then inaccurately represents to the Court that “the
 19 inventors did not offer any amendments that would narrow or ‘surrender’ any subject matter
 20 relating to the containment sleeve.” [Dreamwell’ Opposition, 4:25-28]

21 This statement is false. Dreamwell did make amendments that narrowed and
 22 surrendered subject matter relating to the “containment sleeve.” Dreamwell has failed to
 23 inform the Court that the patentees affirmatively represented to the patent Examiner that the
 24 amendment “more clearly and specifically defined” “the structure and functioning of
 25 applicants’ containment sleeve” and that this statement about the amendment was made to
 26 distinguish the Broyles patent. [See 6/26/96 Amendment, 4:1-5, found in Exh W-F to
 27 Wallace Declaration to Zinus’ Motion for Summary Judgment; the Broyles patent is found in
 28 Exh W-D to Wallace Declaration to Zinus’ Motion for Summary Judgment] This

1 amendment bears an important and direct relation to the “containment sleeve” element and
 2 cannot be passed off as bearing no more than a tangential relation to whether the structure of
 3 the narrowed containment sleeve covers the alleged sheet and tape or bands equivalent.

4 What Dreamwell’s Opposition hides from the Court is as follows. The claims were
 5 initially rejected under 35 U.S.C. § 103 as being unpatentable over the Broyles prior art.
 6 Broyles teaches putting a mattress on a sheet of plastic 19 (see Figure 3 reproduced below),
 7 wrapping the plastic sheet around the mattress, and then sucking air out of the sheet (see
 8 Figure 4), thereby compressing the mattress. The compressed mattress is then inserted (see
 9 Figure 7) into a cover 1. The applicants were obviously not the first to compress a mattress,
 10 and the parallels between the applicants’ invention and Broyles were obvious. Once the
 11 mattress in Broyles is in cover 1, Broyles allows the mattress to return to an uncompressed
 12 state so that it fills the inside volume of cover 1. In making the § 103 rejection, the Examiner
 13 stated that Broyles’ cover 1 satisfied the “containment sleeve” wording of the claim.



20 The applicants then argued that the cover 1 of Broyles was different than the recited
 21 containment sleeve because “Broyles needs only to compress a slight amount” whereas the
 22 applicants’ method was “directed to reducing the volume of coil springs . . . such that the
 23 springs can be shipped”. [1/16/96 Amendment, 3:22-4:6 (emphasis added), found in Exh W-
 24 B to Wallace Declaration to Zinus’ Motion for Summary Judgment] The applicants therefore
 25 added the last two steps of the claim and added the “for shipment” limitation to the “inserting
 26 into a containment sleeve” element. After adding “for shipment”, the applicants represented
 27 to the Examiner that the amendment “more clearly and specifically defined” the “structure
 28 and functioning of applicants’ containment sleeve”. [6/26/96 Amendment (emphasis added),

1 4:1-7, found in Exh W-F to Wallace Declaration to Zinus' Motion for Summary Judgment]

2 This important representation is nowhere mentioned Dreamwell's otherwise detailed
 3 explanation of the prosecution history. In Zinus' view, this omission is inexcusable and can
 4 lead to a distorted reading of the prosecution history. The statement in Dreamwell's
 5 Opposition that "the inventors did not offer any amendments that would narrow or
 6 'surrender' any subject matter relating to the containment sleeve" is false. To the contrary,
 7 the prosecution history reveals that the narrowing amendments bear a direct relation to the
 8 structure and functioning of the "containment sleeve" limitation. The amendment to the
 9 "inserting" element therefore clearly bears "more than a tangential relationship to the
 10 equivalent in question" because the structure and functioning of the narrowed "containment
 11 sleeve" limitation is clearly relevant to whether rolling up a compressed mattress in a sheet
 12 with tape or bands is equivalent to inserting a compressed mattress into a containment sleeve,
 13 as the structure and function of the containment sleeve were narrowed by the amendment.

14 **V. DREAMWELL CANNOT REBUT THE PRESUMPTION OF SURRENDER**
 15 **UNDER THE "UNFORESEEABLE" FESTO EXCEPTION**

16 *Festo XIII* holds that an equivalent is foreseeable if the equivalent was disclosed in
 17 the pertinent art at the time of the amendment. *Festo Corp. v. Shoketsu Kinzoku Kogyo*
 18 *Kabushiki Co.*, 493 F.3d 1368, 1378, 1380, 2007 U.S. App. LEXIS 15942, 83 U.S.P.Q.2d
 19 1385 (Fed.Cir. 2007) (*Festo XIII*). The alleged equivalent (combination of sheet and tape or
 20 bands) was known in the field of the invention at the time of the amendment because the
 21 prior art Magni patent discloses rolling up a compressed mattress assembly in a sheet of film.

22 Dreamwell does not argue that it would not be barred from using the "unforeseeable"
 23 exception if the Magni patent discloses rolling up a compressed mattress assembly in a sheet
 24 of film. Instead, Dreamwell again claims that Zinus has misrepresented that Magni discloses
 25 the alleged equivalent. It is Dreamwell, however, that misrepresents the disclosure of Magni.
 26 It is simply incorrect that Magni "involves wrapping a compressed mattress in a criss-cross
 27 pattern with one or more revolutions of a narrow, ribbon-shaped strand of film."

28 [Dreamwell's Opposition, 14:19-21] Dreamwell's reference to making a criss-cross pattern

with a narrow strand is simply a fabrication. In fact, the dashed lead-line to “C” in figure 13 of Magni denotes that the mattress cover C is underneath (and not visible through) the film 222A. The criss-cross pattern in Figure 13 represents the quilting on mattress cover C of Figure 12 when the compressed mattress is rolled up inside film 222A. As explained in Zinus’ Summary Judgment Reply memorandum, the “ribbon-shaped film 222” becomes the sheet, and “ribbon-shaped strings 230” become the bands. The ribbon-shaped film 222 is not a narrow strand, as Dreamwell represents. Rather, the ribbon-shaped film 222 on the reservoir-spool 220 at the right in Figures 9 and 10 of Magni is as wide as the mattress M₃/M₅/M₇/M_g of Figure 10. It is also apparent from Figures 10 and 13 of Magni that the film 222A does not leave any exposed surface on the circumference of the rolled mattress.

The alleged equivalent of the combination of a sheet and tape or bands was foreseeable as a matter of law because it was disclosed in the prior art at the time of the amendment, and Dreamwell may not use the “unforeseeable” Festo exception to rebut the presumption that claim scope over the alleged equivalent was surrendered by the amendment to the “inserting” claim element that was made for patentability reasons.⁵

VI. CONCLUSION

For the foregoing reasons, Zinus’ Motion for Reconsideration should be granted, and Zinus is entitled to a finding that the swirl wrap method does not fall within the scope of any claim of the ‘142 Patent, either literally or under the doctrine of equivalents.

Dated: January 15, 2008

By: _____/s/_____

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⁵ Although no underlying facts need be considered in this case to preclude Dreamwell from using the “unforeseeable” exception, the resolution of factual issues underlying Dreamwell’s rebuttal under the “unforeseeable” exception could properly be decided by the Court. *Festo X*, 68 USPQ2d at footnote 3.